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Paper 11
Entered: May 19, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE SCOTTS COMPANY LLC
Petitioner

v.

ENCAP, LLC
Patent Owner

Case IPR2013-00491
Patent 8,474,183 B2

Before LORA M. GREEN, RAMA G. ELLURU and ADAM V. FLOYD,
Administrative Patent Judges.

ELLURU, *Administrative Patent Judge.*

DECISION
Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Petitioner, The Scotts Company LLC (“Petitioner”), requests rehearing of the Board’s decision, entered February 5, 2014, (Paper 9, “Decision”), denying institution of *inter partes* review of challenged claims 1-3, 5-10, and 12-15 of U.S. Patent No. 8,474,183 (Ex. 1016, “the ’183 patent”). Paper 10 (“Rehearing Req.”).

In its request for rehearing, Petitioner only requests rehearing of our decision to deny an *inter partes* review of claim 8 and the claims dependent thereon. Rehearing Req. 2, n. 1. Petitioner contends that we erroneously interpreted claim 8, and that our erroneous claim construction materially affected our obviousness analysis. *Id.* at 3-5.

For the reasons set forth below, Petitioner’s request for rehearing is *denied*.

II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988). In its request for rehearing, the dissatisfied party must identify the place in the record where it previously addressed each matter it submits for review. 37 C.F.R. § 42.71(d).

III. DISCUSSION

Petitioner first contends that our erroneous claim construction of claim 8 led to our misconstruing Lignocell and its combination with Huang. Rehearing Req. 5-6. Petitioner contends the Board misconstrued the Lignocell reference in finding that the cited Lignocell picture does not teach placement of the coir product

at the surface of soil. Rehearing Req. 5. According to Petitioner, the inclusion of the word “FIELD” at the upper left corner of the picture and the phrase “Large Scale Soil Improvers/Landscapers” in the third box over the tractor teaches application of mulch to soil field. Rehearing Req. at 5-7. Petitioner further contends that expert declaration testimony would not have been helpful because the technology at issue is easily understandable. *Id.* at 6-7. We conclude that Petitioner has not demonstrated an abuse of discretion.

Petitioner essentially reasserts the argument made in the Petition as to the teachings of the Lignocell reference (Pet. 28) in its Request for Rehearing (Req. Rehearing 5-7). We have, however, based on those arguments, reviewed the picture in Lignocell again, including the wording noted by Petitioner (*Id.*). As we did in our Decision (Decision 7), we find that the picture is unclear as to what material the coir product is placed upon. Ex. 1002, 3 (bottom panel). Specifically, we are not persuaded that the Lignocell picture teaches coir being placed at the surface of soil, as required by claim 8. Petitioner did not provide any additional evidence as to how a person of ordinary skill would have interpreted this picture. As we stated in our Decision, a person of ordinary skill also may interpret the picturing as placing the coir over a soil-less field, such as a rocky, arid landscape, as the picture shows a plant with roots, growing in the watered, expanded coir only. Decision 7. Our determination is buttressed further by Lignocell’s teaching that coir can be used as a growing medium itself. Ex. 1002, 3 (top panel). Specifically, Lignocell depicts a brick of coir placed in a container, to which water and nutrients are added, thereby expanding the coir, and placing a seed on the resulting coir. *Id.* While the record does not contain any additional evidence showing how a person of ordinary skill in the art would have interpreted this

particular picture either, we determine that this picture is readily understandable on its face, as opposed to the picture referred to by Petitioner.

Upon consideration of the evidence, the Board ultimately found that “ . . . for the reasons discussed above with respect to claims 1 and 15, we determine that Scotts has not established a reasonable likelihood that neither the combination of Lignocell, Kessler and Huang nor the combination of Lignocell, Black and Huang, renders obvious independent claim 8. . . .” Decision 11.

Based on the differences between the first limitations recited in claim 8 and claims 1 and 15, Petitioner challenges the Board’s conclusion that the combination of references does not render claim 8 obvious for “the reasons discussed above with respect to claims 1 and 15.” Rehearing Req. 10. As discussed above, Lignocell does not teach the first step of claims 1 and 15 of “placing a mulch product at surface of soil.” Similarly, Lignocell does not teach the first step of claim 8, which requires “placing a mulch product and seed together at [the] surface of . . . soil.” Thus, based on the same rationale we determined that Lignocell’s disclosure does not satisfy the first limitation of claims 1 and 15, we also determined that Lignocel does not teach the first limitation of claim 8.

Petitioner next challenges our determination that Petitioner did not establish a reasonable likelihood that claim 8 was rendered obvious by the combination of Nakishima and Spittle. Rehearing Req. at 14. Petitioner contends that our analysis was flawed because we misconstrued the term “color intensity” as requiring “a degree in the change of color, in order to ‘adjust[] moisture level’ of the surface of soil and/or seed.” Rehearing Req. 4 (citing Decision at 12). Petitioner has not demonstrated, however, that we abused our discretion in interpreting that claim limitation.

The plain and ordinary meaning of “intensity” is degree. *See Webster’s Third New International Dictionary*, 1175 (1961) (defining “intensity” as “extreme or very high degree”)¹. Thus, we interpret “color intensity” as “a degree of color,” and “changing color intensity,” as recited in claim 8, as requiring a change in the degree of color. Moreover, our interpretation is consistent with the ’183 patent’s use of the term “color intensity.” The ’183 patent refers to “color intensity” when discussing dyes, and states that “[c]olor intensity increased with an increase in colorant.” Ex. 1016, 6:58-59. Petitioner has not pointed us to any disclosure in the ’183 patent that provides a different meaning for the term “color intensity.”

In its request, Petitioner refers to the ’183 patent’s statement that “the dye can change color or become visible in response to the moisture levels added to the soil.” Rehearing Req. at 4 (citing Ex. 1016, 7:56-62 (emphasis deleted)). That disclosure does not inform us about the meaning of “color intensity,” but rather refers to “color change.” Claim 8, however, refers to “color intensity” and not “color change” or “becom[ing] visible.” Indeed, claim 13, which depends from claim 8, recites “wherein said dye changes color and/or becomes visible.” Claim 13 does not use “color intensity” as an antecedent basis, and thus, does not narrow the meaning of that term. Rather, claim 13 refers to a different possible property of a dye, i.e., changing color or becoming visible. Thus, it is proper to interpret claim 8 differently from claim 13. *See Karlin Tech. Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971–72 (Fed.Cir.1999) (the doctrine of claim differentiation is based on the common sense notion that different words used in separate claims are presumed to indicate that the claims have different meanings and scope).

¹ The Board enters the relevant dictionary entry from The Condensed Chemical Dictionary, (1961) as Exhibit 3001.

Petitioner contends that even accepting our interpretation of “color intensity,” Nakashima teaches “degrees of color change.” Rehearing Req. 12. Petitioner does not indicate where in its Petition it initially made this argument, but appears to make this argument for the first time in its rehearing request. We could not have misapprehended or overlooked arguments not before us. *See* 37 C.F.R. § 42.71(d). A request for rehearing is not an opportunity to supplement an initial filing and make arguments a party did not make before.

In any event, we are not persuaded by Petitioner’s argument. Petitioner cites to the disclosure of Nakashiam that states “color change materials can effectively exhibit a variety of color changes based on a combination of the functional thermally changing their colors with changing temperature” Rehearing Req. 12 (citing Ex. 1006, 1:42-48). That disclosure teaches a material that *changes color* in response to a change in *temperature*, not moisture content. Ex. 1006 at 1:42-48. As Petitioner notes, Nakashima also states that the color-change materials exhibits a variety of color changes based on “the function of changing the degree of transparency between a transparent state and an opaque state upon application of a medium, e.g. water.” *Id.* Petitioner, however, has not demonstrated that a person of ordinary skill in the art would interpret “changing the degree of transparency” as teaching a change in “color intensity,” as required by claim 8.

Petitioner’s rehearing request also challenges our determination that Petitioner did not demonstrate an adequate rationale for combining Nakashima and Spittle. Rehearing Req. 12-13. Petitioner’s rehearing request does not indicate where in its Petition it made the arguments it now asserts. In any event, we discern no abuse our discretion because we found that Nakashima did not teach the claimed “changing color intensity.”

In view of the foregoing, Petitioner has not proved any clearly erroneous factual findings or erroneous conclusions of law and, Petitioner's request for rehearing is, therefore, *denied*.

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